

REMARKS

This paper is in response to the Office Action dated December 10, 2009. Claims 19, 32-36 have been canceled without prejudice. Claim 18 has been amended to clarify the invention and supported by the original application. Specifically, support for the amendments to Claim 18 can be found in, for example, paragraphs 0044, 0049, 0054 and 0056 of the published application, and Figures 5, 7A and 7B. Claims 20, 25 and 41 have been amended to correct grammatical errors. No new matter is added by the amendments. Upon entry of the amendments, Claims 18, 20-31, 41 and 42 are pending. Applicant respectfully requests the entry of the amendments and reconsideration of the application in view of the amendments and following remarks.

Comments on the Examiner's Official Notice

In the Office Action, the Examiner alleges that Applicant did not properly traverse the taking of Official Notice. Applicant respectfully disagrees.

In rejecting Claim 29, the Examiner took Official Notice stating that "it is old and well known in the transaction arts to print an updated balance on the transaction receipt." Applicant objects to this assertion of Official Notice because printing an updated balance on transaction receipt is not typical or common today at all in credit card or debit card transactions. Applicant does not believe such feature was common knowledge at the time of invention. In light of Applicant's specific challenge, the Applicant respectfully submit that the Examiner must now produce documentary evidence that supports the assertions of Official Notice. See MPEP 2144.03(C). Therefore, Applicant maintains the challenge to the Examiner's assertion of this Official Notice and that no admission of prior art has been made by the Applicant.

Rejection of Claims 18-24, 26, 30 and 31 under 35 U.S.C. 103(a)

The Office Action rejected Claims 18-24, 26, 30 and 31 under 35 U.S.C. 103(a) over Patent No. 6,330,544 (Walker) in view of U.S. Patent No. 6,006,205 (Loeb), further in view of U.S. Patent No. 6,175,823 (Van Dusen), further in view of U.S. Patent Application Publication No. US2002/0016769 (Barbara). Applicant traverses this rejection.

Claim 18

Applicant submits Claim 18 and its dependent claims are patentable over the references.

For the convenience of the Examiner, Claim 18 is reproduced.

18. A method of processing a gift certificate within a credit card account, the method comprising:

receiving, by a computer system of a financial institution, a request for registering a gift certificate in a pre-existing credit card account having a credit card use limit, wherein at least one credit card is associated with the credit card account and is usable in transactions with a plurality of merchants that are to honor the at least one credit card;

subsequent to receiving the request, establishing a gift certificate use limit within the credit card account based on a monetary value of the gift certificate such that the credit card account has a total available credit card use limit that is greater than the credit card use limit;

receiving a plurality of requests for approving a plurality of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account;

approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit, the plurality of transactions totaling a total transaction amount; and

subsequent to approving the plurality of transactions, computing a total charge amount to be charged to an owner of the credit card account for the plurality of transactions, wherein the total charge amount is computed as smaller than the total transaction amount by applying at least some of the gift certificate use limit.

Disclosure of Walker

Walker discloses system and method for issuing and managing gift certificates. According to Walker, a gift giver gives a gift certificate to a recipient for using in purchases from a merchant. The gift certificate is linked to a credit card account of the gift giver such that purchases using the gift certificate are charged to the linked credit card account. Walker discloses mechanisms of linking of the gift certificate to the credit card account and charging the purchases to the credit card account.

Walker does not teach or suggest the concept of “placing value of a gift certificate in a credit card account of a recipient of the gift certificate to enable the use of the value of gift certificate by transactions using the credit card of the recipient.” Applicant notes Walker teaches linking a gift certificate to a credit card account of a gift giver. This is to allow a recipient of the gift certificate to use the gift certificate for transactions, which are charged to the credit card of the gift giver. However, Walker’s linking does not allow the recipient to use the gift certificate value in transactions using a credit card of the recipient. As such, Walker fails to teach the

claimed features “receiving [] a request for registering a gift certificate in a pre-existing credit card account,” “establishing a gift certificate use limit within the credit card account [] such that the credit card account has a total available credit card use limit that is greater than the credit card use limit” and “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit.”

Walker does not teach or suggest the concept of “redeeming value of a gift certificate through credit card transactions without carrying or referring to the gift certificate at any merchant honoring the credit card.” Applicant notes that Walker teaches redeeming value of a gift certificate by linking the gift certificate to a credit card account of the gift giver and by allowing purchases from a merchant to be charged to the linked credit card account. However, Walker does not disclose redeeming gift certificate value through credit card transactions without carrying or referring to the gift certificate. Also, Walker does not disclose use of the gift certificate in connection with merchants that honor the linked credit card. As such, Walker fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “receiving a plurality of requests for approving a plurality of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account” and “approving each of the plurality of transactions.”

Walker does not teach or suggest the concept of “establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card use limit.” Applicant notes Walker’s teaching of linking a gift certificate to a credit card account of the gift giver. However, such linking does not amount to establishing a gift certificate use limit in a credit card account of the recipient and allowing the recipient to use the gift certificate value in credit card transactions of the recipient. Also, Walker teaches nothing similar to allowing transactions exceeding use limit of a credit card account. As such, Walker fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit” and “computing a total charge amount [] for the plurality of transactions [] as smaller than the total transaction amount by applying at least some of the gift certificate use limit.”

Disclosure of Loeb

Loeb discloses credit card billing method and system, which allows multiple items purchased as a single transaction to be separately billed on a credit card. The Office Action relied on Loeb to refer to its disclosure of approving a plurality of transactions using at least one credit card and having a total transaction amount.

Loeb does not teach or suggest the concept of “placing value of a gift certificate in a credit card account of a recipient of the gift certificate to enable the use of the value of gift certificate by transactions using the credit card of the recipient.” Loeb fails to teach the claimed features “receiving [] a request for registering a gift certificate in a pre-existing credit card account,” “establishing a gift certificate use limit within the credit card account [] such that the credit card account has a total available credit card use limit that is greater than the credit card use limit” and “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit.”

Loeb does not teach or suggest the concept of “redeeming value of a gift certificate through credit card transactions without carrying or referring to the gift certificate at any merchant honoring the credit card.” Loeb fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “receiving a plurality of requests for approving a plurality of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account” and “approving each of the plurality of transactions.”

Loeb does not teach or suggest the concept of “establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card use limit.” Loeb teaches nothing similar to allowing transactions exceeding use limit of a credit card account. As such, Loeb fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit” and “computing a total charge amount [] for the plurality of transactions [] as smaller than the total transaction amount by applying at least some of the gift certificate use limit.”

Disclosure of Van Dusen

Van Dusen discloses an electronic gift certificate system, which distributes electronic gift certificates in the form of e-mail documents that include hyperlinks for automating the

redemption process. When a gift certificate recipient selects such a hyperlink, the recipient's computer automatically transmits a claim code to the merchant's website, and the site responds by automatically crediting the recipient's personal account with the gift certificate amount. When the recipient subsequently makes a purchase from the merchant's website, the recipient's account balance is automatically applied to the purchase price.

Van Dusen does not teach or suggest the concept of "placing value of a gift certificate in a credit card account of a recipient of the gift certificate to enable the use of the value of gift certificate by transactions using the credit card of the recipient." Applicant notes Van Dusen's teaching of registering a gift certificate with the merchant's website, which credits the gift certificate amount to the recipient's personal account with the merchant. However, the recipient's personal account is not a credit card account and does not work like a credit card account. As such, Van Dusen fails to teach the claimed features "receiving [] a request for registering a gift certificate in a pre-existing credit card account," "establishing a gift certificate use limit within the credit card account [] such that the credit card account has a total available credit card use limit that is greater than the credit card use limit" and "approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit."

Van Dusen does not teach or suggest the concept of "redeeming value of a gift certificate through credit card transactions without carrying or referring to the gift certificate at any merchant honoring the credit card." Applicant notes that Van Dusen teaches redeeming value of a gift certificate by registering it with the website of the merchant who issued the gift certificate and the gift certificate amount can be used in purchases from the issuing merchant. However, this teaching does not amount to the concept of redeeming a gift certificate through credit card transactions at any merchant honoring the credit card. As such, Van Dusen fails to teach the claimed features "establishing a gift certificate use limit within the credit card account," "receiving a plurality of requests for approving a plurality of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account" and "approving each of the plurality of transactions."

Van Dusen does not teach or suggest the concept of "establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card

use limit.” Applicant notes Van Dusen’s teaching of crediting gift certificate amount to the gift certificate recipient’s personal account and allowing use the money for purchases. However, crediting the gift certificate amount does not amount to establishing a gift certificate use limit in a credit card account and allowing “credit card transactions.” Also, Van Dusen teaches nothing similar to allowing transactions exceeding use limit of a credit card account. As such, Van Dusen fails to teach the claimed features “establishing a gift certificate use limit within the credit card account” and “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit.”

Disclosure of Barbara

Barbara discloses method and system for on-line payment, which includes a person-to-person payment of money as a gift. A customer (sender) of the system initiates sending money to a recipient by designating a source account for the fund and providing an e-mail address of the recipient. See Paragraph 0054. Upon the sender’s approval, the system sends an email to the recipient notifying that the recipient has received the fund from the sender. *Id.* Upon the recipient’s registration for the service, the recipient may receive the fund at a designated credit card account of the recipient. See Paragraph 0055. Then, the money appears as a payment on a statement of the recipient’s credit card account. See Paragraph 0055.

Barbara does not teach or suggest the concept of “placing value of a gift certificate in a credit card account of a recipient of the gift certificate to enable the use of the value of gift certificate by transactions using the credit card of the recipient.” Applicant notes Barbara’s teaching of sending a money gift to a recipient, which can be deposited in the recipient’s credit card as payment to the credit card account. However, a money gift that can be received in a credit card account does not amount to registering a gift certificate in a credit card account. As such, Barbara fails to teach the claimed features “receiving [] a request for registering a gift certificate in a pre-existing credit card account,” “establishing a gift certificate use limit within the credit card account [] such that the credit card account has a total available credit card use limit that is greater than the credit card use limit” and “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit.”

Barbara does not teach or suggest the concept of “redeeming value of a gift certificate

through credit card transactions without carrying or referring to the gift certificate at any merchant honoring the credit card.” Applicant notes that Barbara teaches transferring to a credit card account a fund, which can be used by the credit card. However, this teaching does not amount to the concept of redeeming a gift certificate through credit card transactions at any merchant honoring the credit card. As such, Barbara fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “receiving a plurality of requests for approving a plurality of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account” and “approving each of the plurality of transactions.”

Barbara does not teach or suggest the concept of “establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card use limit.” Applicant notes that Barbara teaches transferring a money gift to a credit card account of the recipient. However, the money shows up as a payment on the statement of the credit card account rather than establishing a gift certificate use limit or increasing the available limit of the recipient’s credit card account. In this regard, Barbara states that “[t]his is **an important feature**, which means, for example, that there is no degradation of points or cash back.” *Id.* In view of this statement, Barbara requires that the money appears as a payment rather than a credit or negative value in the credit card account, which could potentially have an unfavorable impact on a point or cash back program that the credit card account has. As such, Barbara fails to teach the claimed features “establishing a gift certificate use limit within the credit card account,” “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit” and “computing a total charge amount [] for the plurality of transactions [] as smaller than the total transaction amount by applying at least some of the gift certificate use limit.”

Claim 18 is Patentable over References

As discussed above, each of the cited references (Walker, Loeb, Van Dusen and Barbara) fails to teach the claimed features of “receiving [] a request for registering a gift certificate in a pre-existing credit card account,” “establishing a gift certificate use limit within the credit card account [] such that the credit card account has a total available credit card use limit that is greater than the credit card use limit,” “receiving a plurality of requests for approving a plurality

of transactions with a subset of the plurality of merchants using the at least one credit card associated with the credit card account,” and “approving each of the plurality of transactions using based on the total available credit card use limit rather than the credit card use limit.”

The M.P.E.P. states at Section 2145 X. A. that “[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.” *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).”

Applicant notes that the Office Action referred to various portions of the cited references; however, the references are relevant to only fragments of each of the foregoing claimed features. None of these references teach or suggest the inventive concepts:

- (1) placing value of a gift certificate in a credit card account of a recipient of the gift certificate to enable the use of the value of gift certificate by transactions using the credit card of the recipient,
- (2) establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card use limit and
- (3) establishing a gift certificate use limit within a credit card account and allowing credit card transactions exceeding the credit card use limit.

In view of the complete absence of the claimed concepts in the prior art, Applicant submits that the Office Action used Applicant' own disclosure of the claimed concepts to assert obviousness of Claim 18. This is a result of *impermissible hindsight*. At least for this reason, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness for independent Claim 18. Thus, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claim 18 and its dependent claims.

Claim 19 has been canceled and therefore the rejection of that claim is now moot. Claims 20-24, 26, 30 and 31 depend from Claim 18 and further define additional technical features. In view of patentability of Claim 18 and in further view of the additional technical features, Claims 20-24, 26, 30 and 31 are also patentable. Applicant respectfully requests withdrawal of the rejection of Claims 19-24, 26, 30 and 31.

Rejection of Claims 25 and 41

The Office Action rejected Claims 25 and 41 under 35 U.S.C. 103(a) over Walker in view of Loeb, in view of Van Dusen, in view of Barbara and in further view of The Sal Anthony Website Policy on Gift Certificate (Sal Anthony). The Examiner correctly acknowledged that Walker, Loeb, Van Dusen, and Barbara fail to teach or suggest the features of Claims 25 and 41. However, the Examiner relied on Sal Anthony to cure the deficiencies of Walker, Loeb, Van Dusen, and Barbara only with regard to the features of Claims 25 and 41.

Claims 25 and 41 depend from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, Walker, Loeb, Van Dusen, and Barbara fail to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts.

The Examiner relied on Sal Anthony only to provide the features of Claims 25 and 41. However, Sal Anthony does not remedy the foregoing failure of Walker, Loeb, Van Dusen, and Barbara. Accordingly, even if Walker, Loeb, Van Dusen, Barbara and Sal Anthony are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectively submits reconsideration and withdrawal of the rejection of Claims 25 and 41.

Rejection of Claim 42

The Office Action rejected Claim 42 under 35 U.S.C. 103(a) over Walker in view of Loeb, in view of Van Dusen, in view of Barbara and in further view of US Patent No. 7,155,411 (Blinn). The Examiner correctly acknowledged that Walker, Loeb, Van Dusen, and Barbara fail to teach or suggest the features of Claim 42. However, the Examiner relied on Blinn to cure the deficiencies of Walker, Loeb, Van Dusen, and Barbara only with regard to the features of Claim 42.

Claim 42 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, Walker, Loeb, Van Dusen, and Barbara fail to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts.

The Examiner relied on Blinn only to provide the features of Claim 42. However, Blinn does not remedy the foregoing failure of Walker, Loeb, Van Dusen, and Barbara. Accordingly,

even if Walker, Loeb, Van Dusen, Barbara and Blinn are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectively submits reconsideration and withdrawal of the rejection of Claim 42.

Rejection of Claim 29

The Office Action rejected Claim 29 under 35 U.S.C. 103(a) over Walker in view of Loeb, in view of Van Dusen, in view of Barbara and in further view of asserted Official Notice that "it is old and well known in the transaction arts to print an updated balance on the transaction receipt." The Examiner correctly acknowledged that Walker, Loeb, Van Dusen, and Barbara fail to teach or suggest the features of Claim 29. However, the Examiner took the Official Notice to cure the deficiencies of Walker, Loeb, Van Dusen, and Barbara only with regard to the features of Claim 29. As noted above, Applicant specifically objects to the asserted Official Notice and submits that the asserted Official Notice does not establish admitted prior art.

Claim 29 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, Walker, Loeb, Van Dusen, and Barbara fail to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts.

Even assuming *arguendo* that the Examiner is correct regarding Official Notice, the accreted Official Notice does not remedy the failure of Walker, Loeb, Van Dusen, and Barbara. Accordingly, even if Walker, Loeb, Van Dusen, Barbara and the asserted Official Notice are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectively submits reconsideration and withdrawal of the rejection of Claim 29.

Rejection of Claim 27

The Office Action rejected Claim 27 under 35 U.S.C. 103(a) over Walker in view of Loeb, in view of Van Dusen, in view of Barbara and in further view of US Patent Application Publication No. US2003/0195840 (Xu). The Examiner correctly acknowledged that Walker, Loeb, Van Dusen, and Barbara fail to teach or suggest the features of Claim 27. However, the Examiner relied on Xu to cure the deficiencies of Walker, Loeb, Van Dusen, and Barbara only

with regard to the features of Claim 27.

Claim 27 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, Walker, Loeb, Van Dusen, and Barbara fail to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts.

The Examiner relied on Xu only to provide the features of Claim 27. However, Xu does not remedy the foregoing failure of Walker, Loeb, Van Dusen, and Barbara. Accordingly, even if Walker, Loeb, Van Dusen, Barbara and Xu are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectively submits reconsideration and withdrawal of the rejection of Claim 27.

Rejection of Claim 28

The Office Action rejected Claim 28 under 35 U.S.C. 103(a) over Walker in view of Loeb, in view of Van Dusen, in view of Barbara and in further view of asserted Official Notice that "it is old and well known in the transaction arts to print an updated balance on the transaction receipt." The Examiner correctly acknowledged that Walker, Loeb, Van Dusen, and Barbara fail to teach or suggest the features of Claim 28. However, the Examiner took the Official Notice to cure the deficiencies of Walker, Loeb, Van Dusen, and Barbara only with regard to the features of Claim 28.

Claim 28 depends from Claim 18, and therefore are patentable if Claim 18 is patentable. As discussed above, Walker, Loeb, Van Dusen, and Barbara fail to establish a *prima facie* case of obviousness of Claim 18 for their complete failure of the claimed concepts.

The Examiner took the Official Notice only to provide the features of Claim 28. However, the Official Notice does not remedy the failure of Walker, Loeb, Van Dusen, and Barbara. Accordingly, even if Walker, Loeb, Van Dusen, Barbara and the Official Notice are properly combinable (which they are not), the prior art does not establish a *prima facie* case of obviousness of Claim 18. In view of the patentability of Claim 18, Applicant respectively submits reconsideration and withdrawal of the rejection of Claim 28.

Rejection of Claims 32-36

The Office Action rejected Claim 32 under 35 U.S.C. 103(a) over Loeb in view of Van Dusen. The Office Action also rejected Claims 33-35 under 35 U.S.C. 103(a) over Loeb in view of Van Dusen, in view of Barbara and further in view of Walker. Further, the Office Action rejected Claim 36 under 35 U.S.C. 103(a) over Loeb in view of Van Dusen, in view of Walker in view of Barbara in view of Walker and further in view of Xu. Applicant traverses these rejections. However, solely to expedite the prosecution, Applicant has canceled Claims 32-36. As such, these rejections are now moot.

Dependent Claims

Although Applicant has not addressed all the issues of the dependent claims, Applicant respectfully submits that Applicant does not necessarily agree with the characterization and assessments of the dependent claims made by the Examiner, and Applicant believes that each claim is patentable on its own merits. Applicant respectfully submits that pursuant to 35 U.S.C. § 112, ¶4, the dependent claims incorporate by reference all the limitations of the claim to which they refer and include their own patentable features, and are therefore in condition for allowance. Therefore, Applicant respectfully requests the withdrawal of all claim rejections and prompts allowance of the claims.

No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

CONCLUSION

In view of Applicant's amendments to the claims and the foregoing remarks, Applicant respectfully submits that the present application is in condition for allowance. Should the Examiner have any remaining concerns, which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: _____

6/10/2010

By: _____



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